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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91199035
Party	Plaintiff D.C. One Wholesaler, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 77/962853, filed March 18, 2010.
Published in the Official Gazette on November 16, 2010

In the Matter of Supplemental Registration No. 3759575, registered March 9, 2010

D.C. One Wholesaler, Inc.,)	
Petitioner,)	Opposition No. 91199035
)	Ser. No. 77/962853
)	Mark: I ♥ DC
v.)	
)	Cancellation No. _____
)	Reg. No. 3759575
Jonathan E Chien dba I LOVE DC, LLC,)	Mark: I ♥
Respondent.)	DC
)	

**AMENDED NOTICE OF OPPOSITION –
COMBINED OPPOSITION AND PETITION FOR CANCELLATION**

On March 16, 2011, Petitioner D.C. One Wholesaler, Inc. (“Petitioner” or “DC One”) filed a Notice of Opposition against Respondent Jonathan E Chien dba I LOVE DC, LLC (“Respondent”), regarding Ser. No. 77/962853 for the purported mark **I ♥ DC**. Pursuant to 37 CFR § 2.107 and Fed. R .Civ. P. 15(a), Petitioner hereby amends its Notice of Opposition to seek cancellation of the Supplemental Registration No. 3759575 for a similar purported mark **I ♥ DC**. Proceeding as a combined opposition and cancellation proceeding is appropriate under TMBP § 305, as Petitioner’s claims against Respondent’s application and registration involve common questions of law and fact.

Petitioner believes that it will be damaged by registration of the purported mark **I ♥ DC** set forth in Application Serial No. 77/962853, and hereby opposes the proposed registration. Petitioner also believes that it has been and will continue to be damaged by Registration No. 3759575, registered March 9, 2010 on the Supplemental Register, for the purported mark **I ♥ DC**. In particular, Petitioner

DC One asserts (1) that **I ♥ DC** is a merely descriptive and ornamental phrase that is incapable of functioning as a trademark; (2) that others (including Petitioner) have used the ornamental **I ♥ DC** design since before Respondent's applications were filed; (3) that Respondent filed his applications in bad faith and with knowledge that the ornamental **I ♥ DC** design was commonly used by others in the souvenir trade; (4) that Respondent made materially false and fraudulent statements in connection with his applications, with the intent to defraud the U.S. Patent and Trademark Office, and (5) that Respondent sought to obtain trademark registrations in order to inhibit competition in the souvenir trade, to Petitioner's significant harm, as Respondent could try to use such registrations to preclude Petitioner and other sellers of DC-related souvenirs from selling items with the commonly-used, ornamental and descriptive **I ♥ DC** phrase.

This Opposition was timely filed, as it was originally filed on March 16, 2011. This Amendment is being filed electronically through ESTTA, pursuant to the Board's rules, with the additional filing fees being paid through ESTTA.

As grounds for this Combined Opposition and Cancellation Petition, Petitioner alleges as follows:

The Parties

1. Petitioner DC One Wholesaler, Inc. is a District of Columbia corporation located and doing business at 1287 4th Street, NE, Washington DC 20002. Petitioner is a wholesale seller of t-shirts, hats, bags, and other souvenir items. Petitioner sells to vendors, who then sell to the public, mainly tourists visiting the District of Columbia area.

2. On information and belief, Respondent Jonathan E Chien, D/B/A I LOVE DC, LLC (“Respondent”), is an individual and/or District of Columbia limited liability company located and doing business at 1315 4th Street, NE Washington D.C. 20002. Respondent sells t-shirts, hats, bags, and other DC-related souvenir items. On information and belief, Respondent also sells to vendors, who then sell to the public, mainly tourists visiting the District of Columbia area.

3. Respondent filed Application Serial No. 77/962853 on March 18, 2010, for **I ♥ DC** for sweatshirts, T-shirts, baseball caps, skull caps, and polo shirts in Class 25. The application was filed under Section 1(a) of the Trademark Act and claimed a first use in commerce date of February 21, 2006. The application was published for opposition on November 16, 2010.

4. Respondent filed an application for **I ♥ DC** for goods in Classes 18, 25, and 28 on July 28, 2009, for the following goods: Class 18: Backpacks, book bags, sports bags, bum bags, wallets and handbags; Military duffle bags, garment bags for travel, tote bags, shoulder bags and backpacks; Schoolchildren's backpacks; Small backpacks; Tote bags; Class 25: Baseball caps; Cap visors; Caps; Caps with visors; Golf caps; Golf shirts; Headbands against sweating; Hooded sweat shirts; Short-sleeved or long-sleeved t-shirts; Skull caps; T-shirts; Woolly hats; Class 28: Stuffed and plush toys. The application was assigned Ser. No. 77/791078. The application was filed under Section 1(a) of the Trademark Act and claimed a date of first use of September 26, 2005 and a date of first use in commerce as February 21, 2006 for all classes.

5. The Examining Attorney initially refused Application Ser. No. 77/791078 as ornamental under Sections 1, 2, and 45 of the Trademark Act, and gave Respondent the option to amend the application to the Supplemental Register (Office Action, Oct. 30, 2009). The Office Action

stated that the mark “[..] does not function as a trademark to identify and distinguish Registrant’s goods from those of others and to indicate the source of Registrant’s goods.”

6. Respondent amended the application to the Supplemental Register on November 23, 2009. Application Ser. No. 77/791078 therefore was never published for Opposition. The application registered on the Supplemental Register on March 9, 2010 (U.S. Reg. No. 3759575), with a disclaimer of exclusive rights in “DC”.

Allegations Common to All Counts

7. Respondent is one source of goods bearing the ornamental and descriptive phrase **I ♥ DC**. However, Respondent is not the only source of such goods, as Petitioner and many other souvenir vendors sell goods bearing the phrase **I ♥ DC** that did not come from Respondent.

8. Petitioner DC One is a wholesale seller of t-shirts, hats, and other souvenir items. DC One sells to vendors, who then sell to the public, mainly tourists visiting the District of Columbia area. For many years, since before the filing of Respondent’s **I ♥ DC** trademark applications and continuing to the present, Petitioner has sold t-shirts, hats and other items bearing the ornamental and descriptive phrase **I ♥ DC**. Many other wholesalers and vendors sell souvenir goods that also bear the ornamental and descriptive phrase **I ♥ DC**. Such goods are widely available on the Internet and in retail locations throughout Washington D.C.

9. The phrase **I ♥ DC** is widely used as an ornamental and descriptive phrase on souvenir items, including but not limited to t-shirts, sweatshirts, caps, bags and other items. The phrase **I ♥ DC** is a commonly used phrase that connotes information or enthusiasm for visiting and living in DC. The phrase is used, by Petitioner, Respondent and others, in an ornamental and decorative way on t-shirts,

sweatshirts, caps, bags and other items. The phrase **I ♥ DC** is of unknown origin and has been used in many contexts and on many kinds of goods that do not emanate from Respondent.

10. Petitioner and Respondent are located on the same street in Washington DC, and are competitors in the souvenir business in the Washington, D.C. area. Upon information and belief and based on Petitioner's knowledge of the marketplace and investigations, when Respondent filed his trademark applications, he knew that Petitioner and other vendors sold many kinds of goods bearing an **I ♥ DC** design. Respondent statements, at the time of filing his trademark applications, that "no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive," were therefore false and fraudulent Respondent knowingly made those false and material misrepresentations with the intent to defraud the U.S. Patent and Trademark Office and in order to obtain registrations for the commonly-used **I ♥ DC** phrase. On information and belief, Respondent's intent was to use such registrations to inhibit competition in the souvenir market and provide him with a means of threatening and harassing competitors who sell similar **I ♥ DC** merchandise.

Count I: Opposition to Ser. No. 77/962853 – incapable of functioning as a trademark

11. This Count relates to Respondent's application Ser. No. 77/962853. That application was filed on March 18, 2010, for the proposed mark **I ♥ DC** for sweatshirts, T-shirts, baseball caps, skull caps, polo shirts in Class 25, with an asserted first use date of February 21, 2006. The application should be rejected because the proposed mark **I ♥ DC** is incapable of distinguishing Respondent's goods from the goods of others and therefore cannot function as a trademark and an indicator of source.

12. The phrase **I ♥ DC** is widely used as an ornamental and descriptive phrase on souvenir items, including but not limited to sweatshirts, T-shirts, baseball caps, skull caps, polo shirts, and other items. The phrase **I ♥ DC** is a commonly used phrase that connotes information or common sentiments, and/or is used in an ornamental and decorative way on sweatshirts, T-shirts, baseball caps, skull caps, polo shirts, and other items. It has been used in many contexts and on many kinds of such goods that do not emanate from Respondent.

13. On information and belief and based on Petitioner's investigation, Respondent knew, at the time of the filing of his application, of the use of the phrase **I ♥ DC** on sweatshirts, T-shirts, caps, polo shirts, and other items sold by other sellers of souvenirs in the Washington, D.C. area. Despite that knowledge, in his declaration made under oath in his trademark application on March 18, 2010, Respondent stated that "no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive." That material statement was false and fraudulent, and was intended to defraud and mislead the U.S. Patent and Trademark Office.

14. On information and belief and based on Petitioner's investigation, Respondent used the phrase **I ♥ DC** only in an ornamental manner as of the date of filing application Ser. No. 77/962853 on March 18, 2010. The application was originally filed as an application for the Supplemental Register. The specimen submitted was a crystal appliqué bearing the repeat phrase (in contrasting colors): **I ♥ DC I ♥ DC**. As a description of the specimen, Respondent stated: "I LOVE DC Brand [sic] Rhinestone Motif printed on sweatshirts and T-shirts." The specimen was not shown in connection with any goods. The first Office Action (dated 6/27/10) noted the discrepancy between the specimen

and the mark and requested a substitute specimen showing use on the goods. The examiner accordingly asked applicant to amend the application to the Principal Register, which Respondent then did.

15. In response to the first office action, on July 21, 2010, Respondent submitted as specimens photos of a bag with a hang tag bearing the phrase **I ♥ DC** and “distributed by Triple Timber Inc., Washington DC.” On September 1, 2010, an Examiner’s Amendment letter noted that the specimen did not show a Class 25 good. In his September 13, 2010 response, Respondent submitted photos of hats and shirts with souvenir ornamentation, with hand tags bearing the phrase **I ♥ DC**, with **I ♥ DC LLC** in smaller letters. The shirts also appear to have the **I ♥ DC** tags pasted over the inside shirt labels. In the declaration submitted with the substitute specimens on September 13, 2010, Respondent declared under oath that the specimens submitted (the hang tags and shirt labels) were in use in commerce as of the filing of the application (March 18, 2010). The application was then approved for publication on November 16, 2010.

16. On information and belief, and based on Petitioner’s investigation, Respondent did not use **I ♥ DC** on tags or labels, or in any non-ornamental sense, on or before the date of first use alleged in his application, February 21, 2006. On information and belief, Respondent used the **I ♥ DC** only in an ornamental manner as of March 18, 2010, the date on which application Ser. No. 77/962853 was filed. On information and belief, Respondent made hang tags and labels bearing **I ♥ DC** to satisfy the objections of the Trademark Examining Attorney. Respondent’s application was thus materially false. On information and belief, such false statements were made intentionally, and Respondent’s application was filed in bad faith and for an improper purpose in an attempt to obtain a trademark registration for the **I ♥ DC** phrase.

17. Petitioner would be damaged by the issuance of a registration to Respondent. Respondent's application covers the same kinds of goods on which Petitioner and other souvenir sellers use the phrase **I ♥ DC**. Issuing a registration for the phrase **I ♥ DC** would inhibit competition in the souvenir market and would arm this respondent with a means of threatening and harassing competitors who sell similar merchandise.

Count II: Opposition to Ser. No. 77/962853 – Fraud

18. This Count relates to Respondent's application Ser. No. 77/962853. That application was filed on March 18, 2010, for the proposed mark **I ♥ DC** for sweatshirts, T-shirts, baseball caps, skull caps, polo shirts in Class 25, with a claimed first use date of February 21, 2006. The application should be rejected because Respondent knowingly made false and fraudulent statements in the application with the intent to defraud the U.S. Patent and Trademark Office.

19. Based on information and belief and Petitioner's investigation and knowledge, Respondent knew, at the time he filed application Ser. No. 77/962853 on March 18, 2010, that many other souvenir vendors in the Washington DC area sold sweatshirts, T-shirts, caps and shirts using the phrase **I ♥ DC**. Respondent therefore knew, at the time that application Ser. No. 77/962853 was filed on March 18, 2010, that he was not the only vendor of sweatshirts, T-shirts, caps, shirts and other items using the phrase **I ♥ DC**.

20. Despite that knowledge, Respondent declared at the time of filing his trademark application on March 18, 2010, that "no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive." That statement was false and fraudulent, and was made

by Respondent with knowledge of its falsity and with the intent that the Patent and Trademark Office rely on that statement in reviewing Respondent's application and granting him a registration.

21. On September 13, 2010, Respondent submitted substitute specimens, along with a declaration in which Respondent declared under oath that the specimens (hang tags and shirt labels) had been in use on the goods in commerce as of the filing of the application (March 18, 2010). In the Declaration, Respondent declared under oath that "The substitute (or new, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application."

22. Based on information and belief and Petitioner's investigation, the substitute specimens were not in use in commerce at least as early as the filing date of the application (March 18, 2010), and were not used until well after the filing date. Accordingly, Respondent's statement concerning the first use in commerce of the substitute statement was false and fraudulent, and was made by Respondent with knowledge of its falsity and with the intent that the Patent and Trademark Office rely on that statement in reviewing Respondent's application and granting him a registration.

23. Respondent knowingly made the above false and material misrepresentations of fact with the intent to defraud the U.S. Patent and Trademark Office and in order to obtain a registration for the **I ♥ DC** phrase.

24. The above false and fraudulent statements constitute fraud and warrant the rejection of Respondent's application Ser. No. 77/962853 in toto.

Count III: Cancellation of Reg. No. 3759575 - Incapable of functioning as a trademark.

25. Reg. No. 3759575 for **I ♥ DC** in Classes 18, 25, and 28, issued on March 9, 2010 on the Supplemental Register, should be cancelled as the purported mark **I ♥ DC** is incapable of

distinguishing Respondent's goods from the goods of others and therefore cannot function as a trademark or an indicator of source.

26. The phrase **I ♥ DC** is widely used as an ornamental and descriptive phrase on souvenir items, including but not limited to t-shirts, sweatshirts, caps, bags, plush toys and other items covered by Reg. No. 3759575. The phrase **I ♥ DC** is a commonly used phrase that connotes information or enthusiasm for Washington DC. This phrase is commonly used in an ornamental and decorative way on t-shirts, sweatshirts, caps, bags and other items. It has been used in many contexts and on many kinds of such goods that do not emanate from Respondent.

27. Petitioner has been is and will continue to be damaged by the Respondent's Reg. No. 3759575. That registration covers the same kinds of goods on which Petitioner and other souvenir sellers use the phrase **I ♥ DC**. This registration for the phrase **I ♥ DC** could inhibit competition in the souvenir market and improperly provides Respondent with a means of threatening and harassing competitors who sell similar merchandise with the phrase **I ♥ DC**.

28. The specimens filed in connection with application Ser. No. 77791078 (which led to Reg. No. 3759575) show the phrase **I ♥ DC** used solely in a decorative and ornamental fashion – appliquéd on a tote bag, on a handbag, on a t-shirt, on a sweatshirt, and on a plush panda. None of those examples shows a trademark use. On information and belief and based on Petitioner's investigation of the facts, Respondent did not use **I ♥ DC** in a non-ornamental manner, on any goods covered by Reg. No. 3759575, on or before the date of first use alleged in his application, February 21, 2006.

29. On information and belief, Respondent used **I ♥ DC** only in an ornamental manner as of July 28, 2009 (the filing date) and as of November 23, 2009 (the Supplemental Register Date). On

information and belief, Reg. No. 3759575 is not and has not been supported by any specimen showing use of **I ♥ DC** as a trademark in any of the three classes covered by this registration.

30. Petitioner submits that Reg. No. 3759575 was improvidently issued and should be cancelled.

Count IV: Cancellation of Reg. No. 3759575 - Fraud

31. This Count relates to Reg. No. 3759575 for **I ♥ DC** in Classes 18, 25, and 28, issued on March 9, 2010 on the Supplemental Register. That application was filed on July 28, 2009 and converted to a Supplemental Register application on November 23, 2009. The application was filed under Section 1(a) of the Trademark Act and claimed a date of first use of September 26, 2005 and a date of first use in commerce as February 21, 2006 for all classes.

32. The registration should be cancelled because Respondent intentionally made false and fraudulent statements in the application, with the intent to defraud the U.S Patent and Trademark Office.

33. On information and belief and based on Petitioner's knowledge of the marketplace and investigations, Respondent knew, at the time of the filing of his application on July 28, 2009, that many other souvenir sellers used the phrase **I ♥ DC** on t-shirts, sweatshirts, caps, bags, and plush toys. Despite that knowledge, Respondent declared under oath in his trademark application on July 28, 2009, that "no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive." That statement was false and fraudulent, and was made by Respondent

with knowledge of its falsity and with the intent that the Patent and Trademark Office rely on that statement in reviewing Respondent's application and granting him a registration.

34. Respondent knowingly made those false and material misrepresentations with the intent to defraud the U.S. Patent and Trademark Office and in order to obtain registrations for the **I ♥ DC** phrase.

35. In his Application Ser. No. 77791078, which resulted in Reg. No. 3759575, Respondent declared under oath that the specimens submitted showed actual use of the mark on the goods in Classes 18, 25 and 28, as of July 28, 2009.

36. The specimens filed in connection with application Ser. No. 77/791078 do not show use of the phrase **I ♥ DC** as a trademark. They show use solely in a decorative and ornamental fashion – appliquéd on a tote bag, on a handbag, on a t-shirt, on a sweatshirt, and on a plush panda. On information and belief and based on Petitioner's investigation of the facts, Respondent did not use **I ♥ DC** in a non-ornamental manner, on any goods covered by Reg. No. 3759575, on or before the date of first use alleged in his application, February 21, 2006.

37. Accordingly, Respondent's statements concerning the specimens for the goods in Classes 18, 25 and 28, as of July 28, 2009, were false and fraudulent, and were made by Respondent with knowledge of their falsity and with the intent that the Patent and Trademark Office rely on those statements in reviewing Respondent's application and granting him a registration.

38. Respondent knowingly made the above false and material misrepresentations of fact with the intent to defraud the U.S. Patent and Trademark Office and in order to obtain a registration for the **I ♥ DC** phrase.

39. The above false and fraudulent statements constitute fraud and warrant the cancellation of Reg. No. 3759575 in toto..

WHEREFORE, Petitioner D.C. One Wholesaler, Inc. prays:

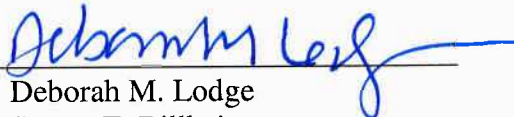
1) That its Opposition to Ser. No. 77/962853 should be sustained and that Application Serial No. 77/962853 should be refused registration, and

2) That its Cancellation Petition should be sustained and Reg. No. 3759575 should be cancelled.

Dated: April 6, 2011

Respectfully submitted,

D.C. One Wholesaler, Inc., Petitioner

By: 

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Attorneys for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 CFR § 2.119, I served a true copy of the foregoing
**AMENDED NOTICE OF OPPOSITION – COMBINED OPPOSITION AND PETITION FOR
CANCELLATION** on Respondent by depositing said copy in the U. S. Mail, first class postage
affixed, addressed to Respondent's attorney of record as follows: JUNGJIN LEE, LEE, LEE &
ASSOCIATES, P.C. SUITE 234, 2531 JACKSON ROAD, ANN ARBOR, MI 48103, on this day,
April 6, 2011.


Deborah M. Lodge